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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/788,995	02/27/2004	Krzysztof Matyjaszewski	00093CON	1410

26285 7590 08/11/2004

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EXAMINER	
CHEUNG, WILLIAM K	

ART UNIT	PAPER NUMBER
1713	

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/788,995	MATYJASZEWSKI ET AL.	
	Examiner	Art Unit	
	William K Cheung	1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 July 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *286-319* is/are pending in the application.

4a) Of the above claim(s) *286-305 and 314-317* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *306-313, 318-319* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *0227*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Applicant's affirmed election of Group IV invention, claims 306-313, 318-319 without traverse is acknowledged. Therefore, in view of lack of traversal to restriction requirement set forth from Response to Restriction Requirement, the restriction set forth by the examiner is deemed proper and is therefore made Final.

2. Claims 286-319 are pending. Claims 286-305, 314-317 are drawn to non-elected claims. Claims 306-313, 318-319 are examined with merit.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 312-313 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 312 (line 5-6), the recitation "wherein the concentration of the first monomer in the second block increases the greater the distance from the first block along the polymer chain" is considered indefinite". The examiner does not understand the recited limitation.

Claim 313 (line 2), the recitation "phylicities" is considered indefinite because without sufficient specificity, one of ordinary skill in art would not know what it means.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 306 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Keoshkerian et al. (US 5,891,971).

The invention of claim 306 relates to ***a block copolymer produced by the process****, comprising:*

polymerizing a ***plurality of first monomers*** *into a polymer chain;*

polymerizing a ***second monomer*** *into the polymer chain wherein a second monomer is polymerized while some of the first monomer remains unpolymerized, wherein adding and polymerizing a second* ***free radically*** *(copolymerizable monomer is conducted after 75% of the first monomer is polymerized.*

Keoshkerian et al. (col. 15-16) in examples I and II disclose a block copolymer using the macromer of example I which is prepared using TEMPO as a living radical initiator. Because the block copolymer of example II involves using the macromer of example I (col. 15-16) which has a conversion of 65 percent, the examiner has a

reasonable basis that the claimed copolymers are inherently possessed in Keosherian et al. Since the PTO does not have proper means to conduct experiments, the burden of proof is now shifted to applicants to show otherwise. In re Best, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977); In re Fitzgerald, 205 USPQ 594 (CCPA 1980).

Regarding the claimed "adding and polymerizing a second **free radically** (co)polymerizable monomer is conducted after 75% of the first monomer is polymerized", applicants must recognize that "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

8. Claims 307 are rejected under 35 U.S.C. 102(b) as anticipated by Keoshkerian et al. (US 5,891,971).

*The invention of claim 307 relates to a **block copolymer produced by the process**, comprising:*

*polymerizing a **plurality of first monomers** into a polymer chain;*

polymerizing a ***second monomer into the polymer chain****, wherein a second monomer is polymerized while some of the first monomer remains unpolymerized, wherein adding and polymerizing a second* ***free radically*** *(co)polymerizable monomer is conducted after 50% of the first monomer is polymerized.*

Keoshkerian et al. (col. 15-16) in examples I and II disclose a block copolymer using the macromer of example I which is prepared using TEMPO as a living radical initiator. Because the block copolymer of example II involves using the macromer of example I (col. 15-16) which has a conversion of 65 percent, the examiner has a reasonable basis that the claimed copolymers are inherently possessed in Keosherian et al. Claim 307 is anticipated.

9. Claims 308-313 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Keoshkerian et al. (US 5,891,971).

The invention of claims 308-310 relates to a ***block copolymer****, comprising:*

a ***first block*** *synthesized from a first monomer;*

a ***second block*** *synthesized from a second monomer; and*

a ***third block*** *synthesized from both the first and second monomers.*

The invention of claim 311 relates to a ***block copolymer****, comprising:* ***at least two monomer blocks*** *synthesized by at least one of a* ***first free radically (co)polymerizable monomer*** *and a* ***second free radically*** *(co)polymerizable monomer, wherein at least one block comprises a tapered copolymer.*

The invention of claims 312-313 relates to an ***AB block copolymer****, comprising: a* ***first block synthesized from a first free radically*** *polymerizable monomers; a* ***second block synthesized from second monomers and first monomers****, wherein the concentration of the first monomer in the second block increases the greater the distance from the first block along the polymer chain.*

Keoshkerian et al. (col. 15-16) in examples I and II disclose a block copolymer prepared by using TEMPO as living radical initiator. Because the block copolymer of example II involves using the macromer of example I (col. 15-16) which has a conversion of 65 percent, the examiner has a reasonable basis that the residual first monomer would facilitate the formation of a tapered block portion in the disclosed copolymers of example II. Since the PTO does not have proper means to conduct experiments, the burden of proof is now shifted to applicants to show otherwise. In re Best, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977); In re Fitzgerald, 205 USPQ 594 (CCPA 1980).

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William K Cheung whose telephone number is (571) 272-1097. The examiner can normally be reached on Monday-Friday 9:00AM to 2:00PM; 4:00PM to 8:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David WU can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

William K. Cheung

Primary Examiner

August 8, 2004

WILLIAM K. CHEUNG
PRIMARY EXAMINER